

Application No.: 09/746,113

REMARKS/ARGUMENTS***Status of the Claims***

Claims 1-20 and 24-31 are currently pending in the application.

Rejections under 35 U.S.C. § 102 should be withdrawn.

Claims 1-5, 11-15, 18-20 and 25 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Weidenhammer et al (USP 6,379,897). Applicants respectfully disagree. Applicants hereby submit that Weidenhammer et al does not anticipate Claims 1-5, 11-15, 18-20 and 25 for at least the following reasons:

The present application claims a method for detecting different mRNAs in a sample comprising: (1) hybridizing the sample with a microarray substrate, wherein the substrate has a plurality of different immobilized probes and wherein the probes are suitable for multiple bases primer extension reactions; (2) synthesizing primer extension products with a nucleic acid polymerase, appropriate reagents and conditions, from the primers and using the mRNAs as templates wherein the primer extension products comprise 5' regions of the mRNAs; and; (3) detecting the primer extension products to determine the level of said different mRNAs wherein target regions of the probes are distributed along the mRNAs.

Weidenhammer et al fails to disclose detecting the primer extension products to determine the level of said different mRNAs wherein target regions of the [immobilized] probes are distributed along the mRNAs.

The Examiner alleges that Weidenhammer et al. discusses that target regions of probes are distributed along the mRNAs. The Examiner cited IL6 as an example [Table

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2]. However, the oligonucleotides cited in Table 2 are for linear amplification of cDNAs. The Examiner fails to point where in the specification the "immobilized probes" for extension reactions are distributed long the mRNA targets for mRNA detection.

Applicants respectfully submit that Weidenhammer et al does not teach all the elements of the claimed invention. Therefore, withdrawal of the rejection under 35 U.S.C. 102(e) is respectfully requested.

Rejections under 35 U.S.C. § 103 should be withdrawn.

Claims 6-10, 16 and 17 are rejected under 35 U.S. 103(a) as allegedly being unpatentable over Weidenhammer et al (USP 6,379,897) in view of Heller et al (USP 5,605,662). Claims 26-29 are rejected as allegedly being unpatentable over Weidenhammer et al (USP 6,379,897) in view of Heller et al (USP 5,605,662) in further view of Chee et al (USP 5,837,832) and Claims 30-31 are rejected as allegedly being unpatentable over Weidenhammer et al (USP 6,379,897) in view of Combimatrix.

Applicants respectfully disagree. As discussed above, the primary reference Weidenhammer et al. fails to teach all of the claim limitations of independent claim 1. Because claims 6-10, 16 and 17, 16-19 and 30-31 are depend on Claim 1, therefore, Weidenhammer et al fails to teach all of the claims limitations of these claims.

Further, Applicants submit that it would not have been obvious to a person of the skill in the art to combine and/or modify the references to make the claimed invention. Therefore, a prima facie case of obviousness has not been established. Applicants respectfully request withdrawal of this rejection.

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CONCLUSION

For these reasons, Applicants believe all pending claims are now in condition for allowance. If the Examiner has any questions pertaining to this application or feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at (408) 731-5000.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account 01-0431.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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